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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/224,620	12/31/1998	SURESH K. MARISSETTY	42390.P2319R	3471

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EXAMINER

AUVE, GLENN ALLEN

ART UNIT	PAPER NUMBER
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2181

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DATE MAILED: 04/02/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/224,620

Applicant(s)

MARISSETTY, SURESH K.

Examiner

Glenn A. Auve

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 and 51-94 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 and 51-94 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Reissue Applications

1. The reissue oath/declaration filed with this application is defective because it fails to identify at least one error which is relied upon to support the reissue application. See 37 CFR 1.175(a)(1) and MPEP § 1414.

While applicant has generally referred to "excess limitations" there is no indication as to what those excess limitations are. In identifying the error it is sufficient to identify a single word, phrase, or expression in the specification or an original claim, and how it renders the original patent to be wholly or partly inoperative or invalid. The declaration must specifically identify an error. (See MPEP § 1414)

Also, there is no new oath in the case to cover the amendments made on April 4, 2001.

2. Claims 1-35 and 51-94 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

3. Claims 51-94 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the

application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

As has been previously stated in this case, the newly presented reissue claims omit the "virtual device driver" limitation which applicant argued in the parent patent made the claims allowable. Applicant has gone to great lengths to argue that even if the omission of the "virtual device driver" limitation makes the claims broader in an aspect germane to the prior art rejection that the newly added limitations at the same time make the claims narrower in an aspect germane to the prior art rejection, and that because of this the recapture rule is avoided. However, the Federal Circuit in *Pannu v. Storz Instruments, Inc.*, 59 USPQ2d 1597 (Fed. Cir. 2001) addressed a similar situation in which the limitation that was added during the prosecution of the original patent to make the claims allowable was omitted in the new reissue claims but those reissue claims also contained further limitations which Pannu argued narrowed the scope of the claims in a way related to what was surrendered. The court concluded that on reissue, Pannu was estopped from attempting to recapture the precise limitation he added to overcome the prior art rejections. The court also pointed to their decision in *Anderson v Int'l Eng'g & Mfg., Inc.*, 160 F.3d 1345, 1349, 48 USPQ2d 1631, 1634 (Fed. Cir. 1998).

Taking claim 51 as an example, applicant has not only removed the "virtual device driver" limitation, but rather the "device driver" limitation itself is gone. Instead of having power management by the "virtual device driver", or as originally claimed in claim 11 the "device driver", applicant has included the limitation of "power management software" which is certainly broader than "device driver" or "virtual device driver". So, in this aspect germane to the prior art rejection applicant has certainly broadened the claim beyond not only the "virtual device driver" limitation which was argued as the reason why the claim was allowable over the prior art, but

has also broadened beyond the originally filed "device driver" for controlling the power management. Examining this situation in light of the court's decision in *Pannu*, applicant has broadened the claim with respect to the very aspect that made the claims allowable over the prior art, i.e. the virtual device driver controlling power management, while narrowing the claim in an aspect that is not material to the prior art rejection, i.e. the addition of the configurable device limitation. Therefore, the claim is not narrowed in any material respect compared with the broadening. As the court held in *Pannu*, applicant is estopped from attempting to recapture the precise limitation added to overcome the prior art rejection. The fact that applicant may have had other limitations that he could have added to overcome the prior art rejection does not bar a recapture rejection.

With respect to the other independent reissue claims applicant also argues that the various configurability and reconfigurable aspects of the claims are narrowing limitations that are somehow material. However the analysis above also applies to the other independent claims as well. Applicant has broadened the reissue claims by eliminating the precise limitation that he argued made them allowable, while adding limitations that are not material to the prior art rejection.

The dependent reissue claims also fail to include the virtual device driver limitations and thus are also rejected for recapture as it applies to the claims on which they depend.

Applicant alternatively argues that the claims are directed to a totally different invention and these are the "overlooked" aspects that were not originally claimed. Applicant states that the configurable aspect was overlooked and that this ability to manage power to configurable devices is what makes at least claim 51 narrower than the original claims. However, the configurable aspect was present in the original patent at least in claim 35. Therefore the argument that this aspect was overlooked seems to be untrue. Since this aspect was not in fact

overlooked in the original patent, even if it were to be found to be materially narrowing, it does not bar a recapture rejection.

Response to Arguments

4. Applicant's arguments filed February 26, 2002, have been fully considered but they are not persuasive.

Applicant has not made any arguments with respect to the rejections of the claims based on a defective reissue oath or declaration nor has any new oath or declaration been provided.

Applicant does argue that adding the term "virtual" in the prosecution of the parent case amounted to merely adding a name to the device driver and that it is not the addition of any structural element and that this addition only implicitly added limitations specifying the characteristics of the power management software by specifying that it be a virtual device driver. However applicant then goes on to give the definition of what a virtual device driver is. Such a limitation does indeed add certain specific characteristics to the device driver term and as such narrows the limitation. Applicant's reissue claims then remove this narrowing limitation which was relied upon in the parent patent for patentability of the claims. This would appear to be the definition of recapture. As noted above, applicant is now attempting to claim only "power management software" which not only has removed the virtual device driver limitation but has also removed the device driver limitation altogether. Applicant's definition of "virtual device driver" includes the device driver running at the privileged ring 0 protected mode of the microprocessor. However, the claims do not include such a limitation, so the argument that applicant is merely using different terms to claim the same thing is not at all persuasive. Applicant argues that there would be no recapture if the virtual device driver term had been

replaced by its definition; however, applicant has not replaced the term with its definition, so certainly recapture can and in this case does exist.

Applicant argues that he has added limitations related to running at the privileged ring 0 protected mode of the microprocessor. However, claim 51, for example, contains no such limitation. Therefore this argument is also not persuasive.

Applicant goes on to argue that limitations added which supervise the power management of devices by the power management software are directly and closely related to the omitted virtual device driver limitation. However, as noted above, even if these limitations were considered to be part of the definition of the virtual device driver, they are not its entire definition. They omit at least the operating the device driver in ring 0 protected mode aspects of the definition. Furthermore, the entire device driver limitation itself has been removed and now only power management software is recited. Such software does not necessarily include a device driver at all. Thus the limitation that was expressly added to the claims in the patent to make them allowable over the prior art, the virtual device driver, has been eliminated from the claims in the reissue application. Such a broadening of the claims violates the recapture rule. Applicant's use of parts of the definition of a virtual device driver, but not all of it, means that the claims have been broadened beyond this limitation's meaning.

Applicant also argues that the certain claim limitations have been added that are related in some way to the definition of the virtual device driver limitation and that because they are so related that recapture is somehow avoided. However as noted above, even though the claims may include some limitations that are in some part of the definition of the virtual device driver, they are not its complete definition. This limitation was added in the patent in order to make the claims allowable. Any broadening of the claims beyond this limitation which was added to make the claims allowable violates the recapture rule. Applicant seems to admit in his arguments that

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the claims have been broadened at least somewhat beyond the virtual device driver limitation but that they are in some way related to the definition of the virtual device driver and that thus they somehow avoid recapture. As noted above, the Court in Pannu explicitly stated that on reissue applicant is estopped from attempting to recapture the precise limitation he added to overcome the prior art rejection. That is what applicant is attempting to do in this case.

Including only certain parts of what makes a virtual device driver a virtual device driver amounts to broadening the claim in an aspect directly related to that which was added to make the claims allowable in the patent.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Glenn A. Auve whose telephone number is (703) 305-9638. The examiner can normally be reached on M-F (8:00 - 5:30) First Friday Off.

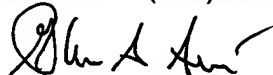
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Wong can be reached on (703) 305-3477. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.


Glenn A. Auve
Primary Examiner
Art Unit 2181

gaa
March 30, 2002